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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/766,307	12/13/96	RIGGINS	

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LM21/0414

M 564

EXAMINER
GECKIL, M.

ART UNIT	PAPER NUMBER
2756	7

DATE MAILED:

04/14/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 12/13/96
☐ This action is FINAL.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 (three) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-42 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration:
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 1-42 is/are rejected.
☐ Claim(s) _____ is/are objected to.
Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☒ The ^{Informal} drawing(s) filed on 12/13/96 are not examined by Draftsman because
☐ The proposed drawing correction, filed on _____ is/are objected to by the Examiner examined by Formal
☐ The specification is objected to by the Examiner. is ☐ approved ☐ disapproved.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892.
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

Art Unit: 2756

1. Claims 1-42 are presented for examination.
2. The following is a quotation of the CFR § 1.71:
 - a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

The specification is objected to under CFR § 1.71, as failing to provide an adequate written description of the invention and failing to adequately teach how to make and use the invention, i.e. failing to provide an enabling disclosure.

Applicants did not teach the details of the communication and applet engines as claimed in claims 31-34, 36-38, 40,41, and configuration engine as claimed in claim 35 and applet host engine as claimed in claim 42. It would require undue experimentation for one of ordinary skill in the data processing art to determine the details of these above said engines. Also, the specification does mention the word "engine" but does not teach details of the engine and how it differs from other programs or processes which provides processing power or an execution means for the instructions. It would take undue experimentation for one of ordinary skill in the data processing art to determine details of how the engine differs from other well known processes or programs or execution means and what the engine is made of. As far as examiner is concerned

Art Unit: 2756

the claimed engine is no more than a label for well known processes or programs or execution means because if there was a difference surely the applicant did not disclose that difference. Specification and figures show servlets but the claims did not have anything to do with servlets. However, claims recite a service provided by the master server. Obviously, servlets are integral part of the application but are reflected in the claims only by implication, e.g. the service. Moreover, teachings regarding to the servlets in the specification are very shallow and lacks the depth required to meet 112 first paragraph requirements, e.g., details of how the servlets and proxy and service are integrated with each other and with the applet to communicate with the server to process request directed to them. Prior art also teaches CGI programs to execute programs at the server side. Servlets are functionally equivalent to these CGI programs. The present application do not disclose such details in depth to make and use the invention without undue experimentation

The examiner contends that it would require repeated undue experimentations for one of ordinary skill in the Internet communication art to make and use the claimed invention for the reasons set forth hereinabove. Applicant is reminded that no new matter is allowed in the amendment to the specification under 35 U.S.C. 132 and 37 CFR 1.118(a).

3. Claims 31-38, and 40-42 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Art Unit: 2756

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foley et al (5,706,502) in view of Mark Brown (Using Netscape 2).

7. Foley et al taught the invention substantially as claimed (e.g., as in exemplary claim 22) including a portfolio management system (PMS) which allowed users to manage, create, edit debug and compile components, or projects, for example, the projects can be Java applets or class libraries or remote Java applets (e.g., see the abstract), the system comprised of all claimed

Art Unit: 2756

means (e.g., see columns 3-12) except the configuration means which configured the attributes of the client but Mark Brown taught all of that (e.g., see pages 901-902 where the PARAM tag is explained. Parameters are the means for configuring the applets and applet user interfaces. Other section of the Java section of the Netscape 2 teaches various other elements of the applet API and how applets are downloaded from the remote server and executed and that how the Java applet API compares to CGI server side execution. For example page 901 teaches "CODEBASE" for specifying the URL as claimed in the claims. It is well known that Netscape does use proxies and it is configurable by the user to use the proxies. It would have been obvious to one of ordinary skill in the Internet communication art at the time of the invention to combine teachings of Foley et al and Mark Brown because they were all directed towards using Java applets and Brown's configuration details complemented teachings of Foley et al in that it just taught that parameters were the configuration means which was skipped by Foley et al due to the scope of Foley et al teachings. Examiner like to point out to the applicant that the claims are very broad and read on any kind of applet execution and interface of applets with the remote servers. Specification and figures show servlets but the claims did not have anything to do with servlets. Moreover, teachings regarding to the servlets in the specification are very shallow and lacks the depth required to meet 112 first paragraph requirements, e.g., details of how the servlets communicate with the server to process request directed to them. Prior art, e.g. Netscape 2 also teaches CGI programs to execute programs at the server side. Servlets are functionally equivalent to these CGI programs for providing a service to the applet or the requester. It is well known in the art

Art Unit: 2756

that and also taught by Netscape 2 that objects are created from the class definitions. Objects have attributes and parameters and they are configurable. Objects are implemented by proxies in the distributed environment e.g. in a distributed environment they use RPC API to communicate between the client and server and they use stubs and stubs act as proxies at both end. These are well known features of distributed environment and examiner is sure that applicant is well acquainted with them since applicant is claiming to invent a distributed execution details. RPC is basics and elementary information for the distributed execution and is taught in the first level courses in the colleges and they include and use proxies for executing a service requested by the client. Claims recite using proxies to provide a service and thus they are rejected accordingly.

8. Examiner will list under the related art in PTO form 892 some references posted by the SUN Microsystem, the inventor of the Java at their Internet site. These references show details of Java API which included the various aspect of using servlets (e.g., see White Paper by Douglas Kramer and "Package java.net" and "Package java.applet" which as a date of April 22 1996. There are innumerable references posted in the Sun Microsystems Internet site regarding to the APIs and examiner cannot possibly cite all of them. Moreover as stated above the inventor must be intimately familiar with this information in order to apply for a patent application which claims the work of integrating a servlet with the applet.

Art Unit: 2756

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mehmet Geckil whose telephone number is (703) 305-9676. The examiner can normally be reached on all days of the week from 8:00 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, , can be reached on (703)305-3817. The fax phone number for this Group is (703) 305-9564.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

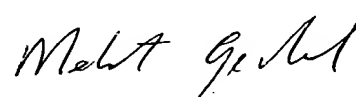
(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-5359 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

4/10/98



MEHMET B. GECKIL
PRIMARY EXAMINER